



UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Application of :
John McCafferty et al :
Serial No.: 09/726,219 : PETITION DECISION
Filed: November 28, 2000 :
Attorney Docket No.: 213839-00013 :

This is a response to the petition under 37 CFR 1.59(b), filed May 8, 2003, to expunge information from the above identified application. The decision on the petition will be held in abeyance until allowance of the application or mailing of an Ex parte Quayle action or a Notice of Abandonment, at which time the petition will be decided.

Petitioner requests that documents submitted as a Proprietary Information Disclosure Statement under a court Protective Order be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid. It is noted that applicants identify three specific documents contained in the envelope as material to be returned. However, the envelope contains four additional documents whose return is not specifically requested. Thus it is not completely clear whether only three documents are to be returned or all seven. A renewed petition at the close of prosecution should clarify this inconsistency.

The decision on the petition is held in abeyance because prosecution on the merits is not closed. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims. Thus, the decision on the petition to expunge must be held in abeyance at this time.

During prosecution on the merits, the examiner will determine whether or not the identified documents are considered to be "material." If the information is not considered by the examiner to be material, the information will be returned to applicant upon close of prosecution. See, in general, M.P.E.P. 724.02.

The petition is at this time **DISMISSED** subject to submission of a renewed petition at the time of allowance or abandonment of the application. No additional petition fee will be required for the renewed petition.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703)308-3824 or by facsimile transmission at (703) 308-7230

A handwritten signature in black ink, appearing to read "Bruce M. Kisliuk", written in a cursive style.

Bruce M. Kisliuk
Director, Technology Center 1600